

U.S. Serial No. 10/709,350  
Examiner: John M. Petruncio  
Art Unit No.: 1751  
Page 7 of 11

Atty. Docket No.: JD-292-US

**REMARKS**

Claim 1-25 are currently pending in the application. Claim 7 has been amended to correct a typographical error. Claims 1, 2, 10, 18 and 25 have been amended. Support for these claim amendments may be found throughout the specification as filed, and in particular in paragraphs 15 and 31 and Examples 1-12.

In view of the foregoing amendments and following remarks, reconsideration and withdrawal of the rejection to the application in the Office Action is respectfully requested.

In the Office Action, the Examiner rejected Claims 1-25 under 35 U.S.C. § 112, first paragraph, because the Examiner took the position that the specification, while being enabling for "concrete", does not reasonably provide enablement for a "soiled porous surface". The Examiner indicated that the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the method of the invention directed to a "soiled porous surface" commensurate in scope with these claims. Applicants respectfully disagree with the Examiner's assessment regarding enablement for a soiled porous surface.

Clearly, one of ordinary skill in the art would readily understand that concrete is one type of a soiled porous surface, as the specification clearly identifies concrete as such. Further, according to MPEP §2164.01 the test for enablement "... requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question "is the experimentation needed to practice the invention undue or unreasonable?" "That standard is still the one to be applied." *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Accordingly, even though the statute does not use the term "undue experimentation," it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988)."

BEST AVAILABLE COPY

**U.S. Serial No. 10/709,350**  
Examiner: John M. Petruncio  
Art Unit No.: 1751  
Page 8 of 11

**Atty. Docket No.: JD-292-US**

Clearly, one of ordinary skill in the art would be readily able to use the inventive method on other types of soiled porous surfaces without any or only minimal additional experimentation. The same methods and compositions disclosed in the specification would be used on other types of soiled porous surfaces. Therefore, Applicants meet the test of enablement, since no additional or only minimal experimentation would be required of one of ordinary skill in the art to practice the inventive method on other porous surfaces. Thus, Applicants respectfully request that the Examiner withdraw his rejection under 35 USC § 112, first paragraph as the specification is clearly enabling for soiled porous surfaces other than concrete.

In the Office Action, the Examiner rejected Claims 1-25 under 35 USC § 103(a) as being unpatentable over U.S. Patent No. 5,656,683 to Ruggiero, et al. further in view of U.S. Publication No. 2002/0065355 to Terasse, et al. Applicants respectfully disagree with the Examiner's assessment regarding the patentability of the rejected claims, based on Ruggiero, et al. '683 further in view of Terasse, et al. '355.

The currently pending claims are directed to a method for enhancing the appearance of a soiled porous surface. The method includes applying a concentrated alkaline cleaning composition to the soiled surface, allowing the cleaning composition to remain on the surface for a period of time, and rinsing the surface with water. Thereafter a maintainer composition, which includes a pore-filling component, is applied to the surface. This maintainer composition remains on the surface for a period of time, after which excess maintainer composition is removed from the surface. At no time is the maintainer composition allowed to form a dried film on the surface, and is, at the dilution ratio practiced by the inventive method incapable of film formation. Further, the subsequent removal of excess maintainer composition from the surface after application would make uniform film formation difficult at best, if not impossible. Contrary to the Examiner's assertion, the maintainer composition utilized in the inventive method would not be considered a "coating composition" by one of ordinary skill in the art because of its content, application dilution ratio, and subsequent removal.

The Ruggiero, et al. '683 reference relates to a cleaning composition comprising a) at least one additive selected from the group consisting of detergents, corrosion inhibitors, organic and aqueous carriers, and combinations thereof, b) a wetting/cleaning agent selected from the group consisting of piperazine-substituted organosulfonates, piperazinone-substituted

Renewal/mailed 10/24/2004 11:55 am d.1 doc

**U.S. Serial No. 10/709,350**  
Examiner: John M. Petruncio  
Art Unit No.: 1751  
Page 9 of 11

**Atty. Docket No.: JD-292-US**

organosulfonates, and combinations thereof, and c) a surfactant selected from a group consisting of alcohol alkoxylates, organic and inorganic salts of polycarboxylated alcohol alkoxylates, and combinations thereof. The Examiner acknowledges that the Ruggiero, et al. '683 reference discusses the cleaning of concrete, but does not include or disclose subsequently applied coating components.

As previously discussed, contrary to the Examiner's assertion, the present invention does not disclose subsequently applied coating components. Rather, Applicants' invention is clearly directed to a maintainer composition which does not form a coating or film in the sense of the Terasse, et al. '355 reference, relied on by the Examiner. One of ordinary skill in the art would be expected to apply a coating composition which forms a semi-permanent or permanent film to the surface after a cleaning. To provide for formation of such a film, this coating composition would not be removed from the surface prior to drying. This is contrary to the present invention which seeks to remove the excess maintainer composition and, as previously discussed, not form a permanent or semi-permanent film. The shortcomings of such a film formation and use on a porous surface are discussed in the "Background" section of the present application. Further, as a further step, the inventive method can include reapplication of the maintainer composition on a periodic basis. One of ordinary skill in the art would know that a coating composition which forms a semi-permanent or permanent film would trap dirt particles and result in a soiled surface. Conversely, subsequent reapplication of the maintainer composition of the present invention to the surface on a periodic basis removes soil from the surface. Clearly, Applicants' invention would not be obvious to one of ordinary skill in the art in view of Ruggiero, et al '683.

The Terasse, et al. '355 reference is directed to a floor polishing composition containing a film-formable organic high molecular material as the main component, which further contains at least scaly particles. The Terasse, et al. '355 reference is clearly directed to film formation and coating a surface with a permanent or semi-permanent film where smoothness of film is critical. Terasse, et al. '355 specifically requires that "the coating is dried at room temperature to form a film". In particular, the Terasse, et al. '355 reference requires a coating amount by one time is 1 to 10 g/m<sup>2</sup> as a solid content to be applied to the floor. See paragraph 116. The Terasse, et al. '355 reference requires that the coating be applied to the surface and allowed to dry. "The scaly particles incorporated in the polishing compositions are aligned by overlying in the film in

**U.S. Serial No. 10/709,350**  
**Examiner: John M. Petruncio**  
**Art Unit No.: 1751**  
**Page 10 of 11**

**Atty. Docket No.: JD-292-US**

parallel to the floor surface, and consequently the particles in the film are present in a face-to-face contact state with each other. Therefore, it is considered that the strength of the film is improved and that an adhesion to the substrate surface is increased." See paragraph 57.

Such a composition clearly differs from the maintainer composition of the present invention, contrary to the Examiner's assertion. As previously mentioned, the inventive method requires that the maintainer composition be applied to the surface and then subsequently removed utilizing, for instance, a wet-vac machine. Therefore, no film formation is allowed to occur. One of ordinary skill would readily recognize that even if a true coating composition was applied to a surface, it would never be subsequently removed prior to drying since such removal would not result in film formation in any sense.

Further, Applicants' dilution of the maintainer composition prior to application to the porous surface would not allow for film formation even if allowed to dry on a surface because there are no potentially solid film forming components present in sufficient quantities to form such a film. What Applicants desire is that the pore filling component fill the pores of the porous surface, not to form a film but to temporarily fill the gaps or pores thereby preventing soil particles from becoming reembedded or deposited in such pores. (See paragraph 15 of the present application). Further, at the dilution ratios of the inventive method, the maintainer composition will never form a film because the maintainer composition never has such a high solids content of a "coating" as is referenced in paragraph 116 of Terasse, et al. '355. Additionally, as a further step, the inventive method can include reapplication of the maintainer composition on a periodic basis. One of ordinary skill in the art would know that a coating composition which forms a semi-permanent or permanent film as in Terasse, et al. '355 would trap dirt particles and result in a soiled surface. Conversely, subsequent reapplication of the maintainer composition of the present invention to the surface on a periodic basis removes soil from the surface.

Clearly, the formulation of the Terasse, et al. '355 reference are film forming coating compositions which are different from the maintainer composition of the present invention. Additionally, the combination of the Ruggiero, et al. '683 reference and the Terasse, et al. '355 reference, alone or in combination, in no way teach, suggest or render obvious the present invention. The Ruggiero, et al. '683 reference makes no mention of applying a maintainer

Renewalms\117-282 US amd-1.doc

**U.S. Serial No. 10/709,350**  
Examiner: John M. Petruncio  
Art Unit No.: 1751  
Page 11 of 11

**Atty. Docket No.: JD-292-US**

composition to a surface after cleaning with a cleaning composition. The Terasse, et al. '355 reference does not teach a maintainer composition as in the present invention, but rather is directed to a coating composition which forms a permanent or semi-permanent coating on a surface. As previously discussed, the maintainer composition of the inventive method does not form such a permanent or semi-permanent coating on the surface and is incapable of forming such a coating. The Terasse, et al. '355 reference clearly teaches the necessity of forming a film coating on the surface. Therefore, a combination of the Ruggiero, et al. '683 reference and Terasse, et al. '355 reference would result in a porous surface coated with a permanent or semi-permanent coating, something clearly distinguished as problematic, undesirable and expensive in the "Background" section of the present application. Thus, the present invention is in no way rendered obvious by the Ruggiero, et al. '683 reference further in view of the Terasse, et al. '355 reference.

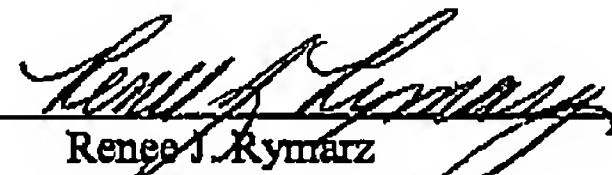
### CONCLUSION

In view of the foregoing remarks and amendments, Applicants respectfully request that the Examiner reconsider and withdraw the rejections discussed above. Applicants also solicit an early notification of allowance. If the Examiner Petruncio has any questions, or believes a telephone discussion would expedite prosecution, he is invited to contact the undersigned at telephone number 262-631-4495.

The Commissioner is hereby authorized to charge any fees which may be due, or to credit any overpayments made, to Deposit Account No. 50-0231.

Respectfully submitted,

Dated: 9 December 2004

By:   
Renee J. Rymarz  
Registration No. 35,606

JohnsonDiversey, Inc.  
8310 16<sup>th</sup> Street - M/S 509  
P.O. Box 902  
Sturtevant, Wisconsin 53177  
Direct Phone: 262-631-4495

**This Page is Inserted by IFW Indexing and Scanning  
Operations and is not part of the Official Record**

## **BEST AVAILABLE IMAGES**

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ **BLACK BORDERS**
- ☐ **IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- ☐ **FADED TEXT OR DRAWING**
- ☐ **BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- ☐ **SKEWED/SLANTED IMAGES**
- ☐ **COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- ☐ **GRAY SCALE DOCUMENTS**
- ☒ **LINES OR MARKS ON ORIGINAL DOCUMENT**
- ☐ **REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- ☐ **OTHER:** \_\_\_\_\_

**IMAGES ARE BEST AVAILABLE COPY.**

**As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.**